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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,666	08/07/2003	Masayuki Fujita	21581-00258-US2	9995

30678 7590 04/19/2005

CONNOLLY BOVE LODGE & HUTZ LLP  
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WASHINGTON, DC 20036-3425

EXAMINER
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MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/635,666	<b>Applicant(s)</b> FUJITA ET AL.	
	<b>Examiner</b> Sanza L. McClendon	<b>Art Unit</b> 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 and 46-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-25, 31-37 and 45 is/are rejected.
- 7) ☒ Claim(s) 26-30 and 38-44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Amendment***

1. In response to the Amendment received on February 1, 2005, the examiner has carefully considered the amendments.

### ***Response to Arguments***

2. Applicant's arguments, see Response, filed February 1, 2005, with respect to claims 21-45 have been fully considered and are persuasive. The rejection of claims 21-25, 31-36 and 45 under 35 USC 102(e) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Fujitia (WO 99/056216) and under 35 USC 102(e) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Fujitia et al (US 6,407,164 and US 2002/0086942) has been withdrawn. The translation of priority document JP 10/285797, filed 10/08/1998 is sufficient to overcome the above rejections. However, claims 21-45 are now subject to an obviousness-type double patenting rejection over the above art. See below.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 21-25, 31-37, and 45 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 13-15 of U.S. Patent No. 6,407,146.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to comprise overlapping subject matter. The difference between the two appears to be the high molecular weight plasticizer having an average molecular weight of 500 or over. However 6,407,146 per column 17, lines 42-43 teaches adding plasticizers, such as chlorinated paraffin's (which is a mixture of hydrocarbons of high molecular weight) to adjust the viscosity and other physical properties. Therefore it would have been within the skill of an ordinary skilled artisan at the time of the invention to use a high molecular weight plasticizer with a vinyl polymer having at least one crosslinkable silyl group represented by the formula found in both disclosures. The motivation would have been a reasonable expectation of adjusting the physical properties and viscosity as taught in 6,407,146. Fujitita et al (6,407,146).

5. Claims 21-25, 31-37, and 45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 4-9, and 18-23 of U.S. Patent No. 6,552,118. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to comprise overlapping subject matter. Although claims 1-2, 4-9 and 18-23 are written as method claims, said claims are defined by the composition as found in the claims, which appear to overlap with the instant invention; wherein the difference between the two appears to be the high molecular weight plasticizer having an average molecular weight of 500 or over. However 6,552,118 per column 20, lines 43-44 teaches adding plasticizers, such as chlorinated paraffin's (which is a mixture of silyl hydrocarbons of high molecular weight) to adjust the viscosity and other physical properties. Therefore it would have been within the skill of an ordinary skilled artisan at the time of the invention to use a high molecular weight plasticizer with a vinyl polymer having at least one crosslinkable silyl group represented by the formula found in both disclosures. The motivation would have been a reasonable expectation of adjusting the physical properties and viscosity as taught in 6,552,118.

#### ***Allowable Subject Matter***

6. Claim 26-30 and 38-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach a composition comprising a vinyl polymer having at least one crosslinkable group such as alkenyl, hydroxyl, epoxy or amino functional groups and a high molecular weight plasticizer having an average molecular weight of 500 or over that is a vinyl or (meth) acrylic polymer having a molecular weight distribution value of less than 1.8 obtained by either living polymerization or atom transfer polymerization techniques.

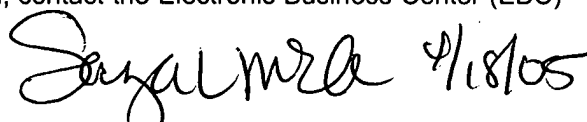
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**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Sanza L. McClendon", followed by the date "4/18/05".

Sanza L. McClendon

Examiner

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SMc